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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/823,400

04/13/2004

Ralph Baucr

1055-A4363

3239

34456

7590

11/09/2007

LARSON NEWMAN ABEL POLANSKY & WHITE, LLP

5914 WEST COURTYARD DRIVE

SUITE 200

AUSTIN, TX 78730

EXAMINER

YOON, TAE H

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

11/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/823,400

Applicant(s)

BAUER ET AL.

Examiner

Tae H. Yoon

Art Unit

1796

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 October 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

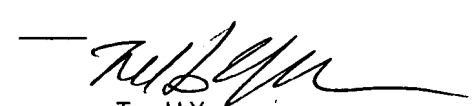
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL -324).
5. ☒ Applicant's reply has overcome the following rejection(s): rejection of claim 4 under Yoshino et al.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____
Claim(s) objected to: _____
Claim(s) rejected: 1-4, 6-22 and 24-34
Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____


Tae H Yoon
Primary Examiner
Art Unit: 1796

ATTACHMENT TO ADVISORY ACTION

New claims 53 and 54 having a limitation found in specification after final rejection raise new issues that would require further consideration and search and thus, amendment will not be entered.

All rejections are maintained (except for the rejection of claim 4 under Yoshino et al (US 6,576,324)) for reason of record with following response.

1. Applicant asserts that the final rejection is incomplete and lacks clarity, and requests a new office action, but the examiner does not see any reason for a new office action. Applicant traversed an apparent Official Notice, but there is no Official Notice. The examiner stated that the instantly recited properties are inherent in the cited art since the same materials are used. Since PTO does not have equipments to conduct the test, it is fair to require applicant to shoulder the burden of proving that his material differs from those of cited art. *In re Best*, 195 USPQ 430, 433 (CCPA 1977).

With respect to "Bugosh teaches" under the heading of Napier et al (US 3,356,791), said "Bugosh" in "Bugosh teaches" is an obvious typo since said phrase appeared under the heading of Napier et al, and since the examiner clearly stated that "applicant asserts that **Napier** is silent ---" in the previous sentence.

With respect to claim 4 under Yoshino et al (US 6,576,324), the examiner does not believe there lacks clarity since applicant could have amended claims if he did not see acrylic resin in Yoshino et al rather than requesting a new office action.

2. Again, 35 U.S.C. 112, 2nd Pp is maintained for reason of record.

3. With respect to Bugosh, again, the examiner stated that the instantly recited properties are inherent in the cited art since the same materials are used. Since PTO does not have equipments to conduct the test, it is fair to require applicant to shoulder the burden of proving that his material differs from those of cited art. *In re Best*, 195 USPQ 430, 433 (CCPA 1977). The asserted "activated anisotropic boehmite particles" found in specification is not the claimed limitation, and thus such assertion has no probative value. Applicant's example TEW-464 used a different thickener (QR-708) from those in comparative examples (CAM 9010 or CAM 9010 and nanoclay), and thus a fair comparison for any unexpected result of boehmite cannot be made.

Th examiner had pointed out that Bugosh teaches employing 1-40% of said boehmite, and thus overlapping range is anticipation.

4. With respect to claim 4 under Yoshino et al (US 6,576,324), the examiner does not believe there lacks clarity since applicant could have amended claims if he did not see acrylic resin in Yoshino et al rather than requesting a new office action. Again, rejection of claim 4 is withdrawn. See, *In re Best*, 195 USPQ 430, 433 (CCPA 1977).

5. With respect to "Bugosh teaches" under the heading of Napier et al (US 3,356,791), said "Bugosh" in "Bugosh teaches" is an obvious typo since said phrase appeared under the heading of Napier et al, and since the examiner clearly stated that "applicant asserts that **Napier** is silent ---" in the previous sentence. See, *In re Best*, 195 USPQ 430, 433 (CCPA 1977).

6. See above response.

7. New claims 53 and 54 will not be entered as the reason given above.

8. Applicant failed to traverse Double Patenting rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Tae H Yoon
Primary Examiner
Art Unit 1796

THY/Nov. 8, 2007